

REMARKS

I. Status of Claims

Claims 1-23 are pending. No amendment has been made herein.

II. Rejection under 35 U.S.C. § 103(a)

The Examiner rejects claims 1-23 under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent No. 6,521,219 to Hirata ("Hirata"), in view of U.S. Patent No. 6,076,530 to Braida-Valerio et al. ("Braida-Valerio") and U.S. Patent No. 6,303,110 to Maubru et al. ("Maubru") for the reasons set forth at pages 2-4 of the Office Action. The Examiner contends that Hirata teaches a method of repairing or restoring damaged hair by applying a "nourishing" composition to the hair, compressing the hair shafts between heated plates, such as a iron, heated to a temperature of 130-180°C, and then optionally carrying out a styling treatment, such as a permanent, on the hair. Office Action at 2-3. The Examiner admits that Hirata teaches neither the use of a ceramide nor the use of reducing or oxidizing agents, but relies on Braida-Valerio and Maubru for their teachings of these two elements, respectively, in treating hair. *Id.* at 3.

Specifically, the Examiner contends that "[i]t would have been obvious ... to combine Hirata's teachings with those of Braida-Valerio because Hirata teaches a method of nourishing hair by treating a composition that has been applied to the hair and Braida-Valerio teaches that hair benefits from heating a composition comprising ceramide." *Id.* at 3-4. The Examiner further contends that it would also have been obvious to combine Hirata's teachings with those of Maubru "because Hirata specifically teaches that a permanent treatment can be conducted after applying an iron to the hair, and [Maubru teaches] that the most common technique for permanently reshaping the

hair comprises application of a reducing and then oxidizing agent." *Id.* at 4. Applicants respectfully traverse the rejection for at least the following reasons.

In making a rejection under 35 U.S.C. § 103, the Examiner has the initial burden to establish a *prima facie* case of obviousness. See M.P.E.P. § 2143. In its recent decision in *KSR Internat'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q. 2d 1385 (2007), the Supreme Court confirmed that the "framework for applying the statutory language of §103" was still based on its landmark decision in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). Under *Graham*, there are four factors for consideration when determining whether an invention is obvious:

- (1) the scope and content of the prior art;
- (2) the differences between the prior art and the claims at issue;
- (3) the level of ordinary skill in the art; and
- (4) secondary considerations.

However, the Court indicated that there is no necessary inconsistency between the idea underlying the teaching, suggestion, or motivation ("TSM") test and the *Graham* analysis. *KSR*, 127 S. Ct. at 1741, 82 U.S.P.Q. 2d at 1389. As long as the TSM test is not applied as a "rigid and mandatory" formula, the test can provide "helpful insight" to an obviousness inquiry. *Id.*

Here, a *prima facie* case of obviousness has not been established because there would have been no motivation to add the ceramides of Braida-Valerio's steam-treatment to the process for applying a heating iron to hair treated with amino acid or peptide "nourishing" compositions as taught in Hirata with the reasonable expectation of arriving at the invention recited in the present claims. Office Action at 5-6. Specifically,

nothing in Hirata readily suggests the need to use any composition other than that already used by Hirata as a means for creating softer or smoother hair. Hirata's invention repairs or restores damaged hair and thus one of ordinary skill reviewing Hirata's disclosure would not have been motivated to try to improve upon it by looking at other hair treatment processes. Similarly, nothing in Braida-Valerio suggests the use of its ceramide compositions in a process involving a heating iron instead of steam. Maubru is relied on only for its disclosure of the details of a permanent reshaping process. In the *KSR* decision, the court recognized that a showing of "teaching, suggestion, or motivation" could provide helpful insight in determining whether the claimed subject matter is obvious under Section 103(a). 127 S. Ct. at 1731. Here, Applicants submit that Hirata, Braida-Valerio, and Maubru provide no guidance or motivation, either expressly or implicitly, to combine their teachings.

The Federal Circuit has held that even when combining the various components of a claimed composition may have been obvious to try, it does not constitute the standard for combining references under section 103, if the Examiner's rationale requires one to pick certain aspects that meet the claimed invention, while excluding the full teachings of the references. *In re Geiger*, 815 F.2d 686, 687, 2 U.S.P.Q. 2d 1276, 1278 (Fed. Cir. 1987); cf. *In re Wesslau*, 353 F.2d 238, 241, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965) (holding "[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art").

Finally, Applicants note that Hirata discloses a method for nourishing hair with a composition comprising amino acids and peptides to improve shininess, resiliency and smoothness. See column 10, lines 19-20. In contrast, the present application expressly cites that conditioners comprising amino acids and peptides “do not entirely eliminate the damage done to the hair and its properties.” *Id.* at paragraphs [0005] to [0006] of the as-published application. Thus, the present application is actually improving upon the teachings disclosed in Hirata.

Declaration Under 37 C.F.R. §1.132

To further support their position and advance prosecution, Applicants submit herewith the Declaration of Laurence PAUL under 37 C.F.R. § 1.132 (“Declaration”).¹ The Declaration demonstrates differences in smoothness with prepared hair samples according to the process in the claims and hair samples prepared according to the process disclosed in the prior art reference, Braida-Valerio, which lacks the use of an iron for penetrating the composition into the hair but instead uses gas steam. See Declaration at paragraph 5. Specifically, a composition comprising ceramide, the composition prepared in accordance with the claims, was applied to two separate locks of human hair. The first lock was subjected to the process as disclosed in accordance with the present claims and compared to the second lock which was subjected to the process described in Braida-Valerio. The first lock demonstrated unexpected superior smoothness and softness compared with the second lock treated with the process described in the prior art. See Declaration at Table II.

¹ Applicants note that the declaration filed with this response is unsigned because Mme. PAUL was unavailable to sign the final version prior to the February 29, 2008 deadline. Applicant will replace the unsigned declaration with a signed version on or about March 10, 2008. If the Examiner has any questions in the meantime, she is requested to call the undersigned at 202 408 4454.

Thus, the specific combination of applying to the hair a composition comprising ceramide and then subjecting the hair to a process using an iron to heat the hair, as presently claimed, resulted in significantly better smoothness, softness, and uniformity than the steam process. It appears that the moisturizing properties of the steam may hinder the ceramide from penetrating better and more uniformly into the hair. These results were unexpected given that it was not known and could not be predicted that using a specific combination of applying a ceramide composition to the hair and applying a hot iron would lead to improved smoothness and uniformity. See page 2, paragraph [007] of the as-filed application.

Thus, the unexpected and unpredictable results shown in the Declaration support Applicants' position that the claimed invention would have not have been obvious. "Evidence of unobvious or unexpected advantageous properties, such as superiority in a property the claimed compound shares with the prior art, can rebut *prima facie* obviousness" M.P.E.P. § 716.02(a) (quoting *In re Chupp*, 816 F.2d 643, 646,2 U.S.P.Q.2d 1437, 1439 (Fed. Cir. 1987). In light of the above, Applicants respectfully request that the Examiner withdraw the rejection under section 103.

III. Conclusion

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 26, 2008

By: Deborah M. Herzfeld
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Attachment: Executed Declaration under 37 C.F.R. § 1.132 of Laurence PAUL